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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,761	07/02/2003	Lishan Aklog	FLEX-001	7167
24353	7590	02/24/2005	EXAMINER	
BOZICEVIC, FIELD & FRANCIS LLP 1900 UNIVERSITY AVENUE SUITE 200 EAST PALO ALTO, CA 94303			PREBILIC, PAUL B	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/613,761

Applicant(s)

AKLOG, LISHAN

Examiner

Paul B. Prebilic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 5, 14-16, 18, 19, 21-23, 25, 26, 29-44, 50, 54 and 58-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, 17, 20, 24, 27, 28, 45-49, 51-53 and 55-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date various.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

Applicant's election with traverse of **Group 1 and Species E (Figure 3D)** in the response filed December 2004 is acknowledged. The traversal is on the ground(s) that **there is no additional serious burden to search all the additional inventions**. This is not found persuasive because the election of Group I requires additional searching of at least 623/2.37 that is not required by the election of the other groups. The election of Group II would require additional searching of at least 623/902 and 623/904, and the election of Group III would require the additional searching of 623/6.12 as well as 623/6.36. Not only would there be additional searching required with the examination of other groups, the Examiner would also have to spend time evaluating the claims with respect to the prior art. The requirement is still deemed proper and is therefore made FINAL.

Claims 5, 14-16, 18, 19, 21-23, 25, 26, 29-44, 50, 54, and 58-62 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions or species, there being no allowable generic or linking claim. Applicant timely **traversed** the restriction (election) requirement in paper filed in December 2004. Claims 18, 19, 21-23, 25, 26, 29-44, 50, 54, and 58-62 were indicated by Applicant's Representative as being drawn to the non-elected groups or species. However, upon careful review of the claims, it was determined that claims 5 and 14-16 were also drawn to non-elected species, and therefore, these claims have been withdrawn as well.

***Double Patenting***

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 27, 28, and 45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 16, and 17 of copending Application No. 10/884,015. The present claims are read on by the copending claims such that the present claims are considered to be clearly obvious in view thereof. In other words, the present claims could be said to be "anticipated" or rendered clearly "obvious" by the subject matter set forth in the copending claims, and therefore, a double patenting rejection is deemed appropriate.

This is a provisional obviousness-type double patenting rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 9, the terminology "string-like" is considered indefinite for the same reasons that "or the like" is considered indefinite in that there is no clear boundary as to what is "string-like" and what is not; see MPEP 2173.05(b) and the second to last paragraph thereof that is incorporated herein by reference.

Regarding claim 10, the terminology "ribbon-like" is considered indefinite for the same reasons that "or the like" is considered indefinite in that there is no clear boundary as to what is "string-like" and what is not; see MPEP 2173.05(b) and the second to last paragraph thereof that is incorporated herein by reference.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Mahmoodi (WO 98/18411). Mahmoodi anticipates the claim language where the ring as claimed is met by the ring of Mahmoodi, the restraining structure as

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claimed is part of the ring and is made up of the connecting struts (14, 16); see the front page of the patent and its English language abstract.

Claims 1-3, 6-12, 27, 45-49, and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Gabbay (WO 01/89418). Gabbay anticipates the claim language where the buttress (20) extends over at least a portion of the interior of the ring; see Figures 1, 4, 11, and 12 as well as page 9, line 26 et seq.

Claims 1-4, 9-13, 17, 20, 24, 27, 28, 45, 46, 51, 52, and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Bessler where the restraining member as claimed is met by the template (206) of Bessler that reads on the claimed device; see Figures 9A and 9B as well as page 14.

Regarding claim 20, "substantially" is construed as being broad such that the arms of template (206) reads thereon.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bessler et al (WO 01/47438) in view of Solem et al (US 6,210,432). Bessler et al meets the claim language but discloses that the device can be made of plastic or metal without specifying what types of metals can be

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used. However Solem teaches that it was known to make similar annuloplasty rings out of Nitinol; see column 3, lines 37-47. Nitinol is a type of nickel-titanium alloy. Therefore, it is the Examiner's position that it would have been prima facie obvious to make the component(s) of Bessler out of Nitinol for the same reasons that Solem does the same and because Nitinol is known to be a biocompatible and sufficiently strong material for heart valve repair as implicitly taught by Bessler.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action unless such applications are stored in image format (i.e. IFW). Generally, those applications filed or amended after July 1, 2003 are image file wrapper (IFW) applications.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul B. Prebilic whose telephone number is (571) 272-4758. The examiner can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic  
Primary Examiner  
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